UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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DEC -2 2002

Paper No. 21

In re Application of :
Martin Cullen : DECISION ON PETITION
Application No. 09/864,350 :
Filed: May 25, 2001 :
Attorney Docket No. P-3925-1

This is a decision on the petition filed on November 4, 2002 by which petitioner requests supervisory review of the examiner's holding that required withdrawal of newly submitted claim 2 filed on July 24, 2002 as being for an invention that was independent or distinct from the invention of claim 1 which had previously been examined. No fee is required for the petition.

The petition is denied.

Petitioner argues that the examiner acted improperly in withdrawing claim 2 from consideration under 37 CFR 1.142(b) because 37 CFR 1.142(a) requires that an applicant be given an action to elect the claims to which the application will be restricted, and an opportunity to reply to that action. Petitioner opines that in requiring restriction, and then withdrawing claim 2 from examination without first "making a restriction requirement" and then permitting petitioner to elect according, the examiner has violated the procedural requirements of 37 CFR 1.142.

Petitioner's argument is totally unpersuasive, given that the examiner's action appears to be strictly in accordance with the practice set forth in MPEP § 821.03 - "Claims for Different Invention Added After an Office Action". Petitioner is invited to consider the language of 37 CFR 1.145, the basis for the practice in MPEP § 821.03. 37 CFR 1.145 states:

> "If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, **the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered**, subject to reconsideration and review as provided in §§ 1.143 and 1.144. (Emphasis supplied.)

Petitioner has **not** argued that claim 2 presented other than an invention independent or distinct from the invention of claim 1, nor has petitioner argued that claim 1 was not acted upon. Therefore, it is clear that the examiner has acted properly under 37 CFR 1.145, and has neither abused her discretion nor acted in a manner that was in any way arbitrary of capricious. That being the case, there is no basis upon which petitioner is entitled to relief from the examiner' action.

Petitioner may file a request for reconsideration of this decision, without fee, provided that the request is filed within two months of the date of this decision. See 37 CFR 1.181(f). Petitioner is advised that in accordance with 37 CFR 1.181(f), the time for taking action under 37 CFR 1.192, or such other action in response to the final rejection as may be appropriate, continues to run as set forth in 37 CFR 1.192, was neither tolled nor extended by the filing of the instant petition, and will not be tolled or extended by the filing of a request for reconsideration of this decision.

The application is being retained in Technology Center 3700 pending further action by petitioner.

PETITION DENIED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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